

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Dinah W.Y. Sah et al.	Art Unit :	1647
Serial No. :	10/661,984	Examiner :	Robert S. Landsman
Filed :	September 12, 2003	Conf. No. :	9412
Title :	NOVEL NEUROTROPHIC FACTORS		

**MAIL STOP PETITIONS / OPLA**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b)**

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application at the time of allowance. The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) included with the Notice of Allowance mailed on September 19, 2006 states that the Total PTA is 418 days. As detailed herein, applicant respectfully requests reconsideration of the PTA calculation to increase the Total PTA from 418 days to **467 days**.

The Issue Fee Transmittal along with fee payment for the above-referenced application is being filed today under separate cover to Mail Stop Issue Fee.

### REVIEW OF PATENT TERM ADJUSTMENT CALCULATIONS

A review of the PTA History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the PTA for events between the filing of the application and allowance as follows:

(1) PTO mailing of a first Office Action, due at 14 months from the application filing date of September 12, 2003, and actually mailed on February 22, 2006.

Applicant agrees with the calculation of 467 days of PTO Delay.

(2) Applicant's response after Non-Final Action due on May 22, 2006 and actually received by the PTO on May 19, 2006.

Applicant agrees with the calculation of 0 days APPL delay related to the filing of this response.

(3) Applicant's Supplemental Response mailed by express mail on July 5, 2006.

Applicant disagrees with the calculated APPL delay of 49 days. As detailed in sections (A) and (B) below, applicant contests two distinct aspects of the calculation of 49 days of APPL delay.

#### *(A) Applicant's Supplemental Response Should not Have Triggered Applicant Delay*

As referenced in item (3) above, Applicant filed a Supplemental Response on July 5, 2006 in direct response to the Examiner's request for same made during a telephonic interview with the undersigned on June 22, 2006. The Examiner's request for a Supplemental Response was accommodated by Applicant in a timely manner and mailed to the PTO by express mail. This Supplemental Response to the Examiner's telephonic request does not constitute a failure of Applicant to engage in reasonable efforts to conclude examination and is specifically accommodated in 37 CFR 1.704(c)(8). As a result, Applicant respectfully submits that no APPL Delay is warranted and that the 49 days of APPL Delay should be removed in its entirety.

*(B) Applicant's Supplemental Response was mailed by Express Mail on July 5, 2006  
(not July 7, 2006)*

In addition to the issue in section (A) above of whether *any* APPL Delay should be applied, the number of 49 days is the result of a clear clerical error of the PTO. Applicant's supplemental response was mailed by express mail on July 5, 2006 (copies of the express mail declaration and receipt, both correctly stamped July 5, 2006, are enclosed) but was incorrectly entered by the PTO as July 7, 2006 (a copy of the date-stamped postcard, incorrectly stamped July 7, 2006, is enclosed). Since the date stamped on the postcard should have been July 5, 2006 (not July 7, 2006), APPL delay should have been entered as at most 47 days (instead of 49 days). However, Applicant emphasizes that the request under this section is merely secondary to that made in section (A) above and will be rendered moot if APPL delay is recalculated as 0 days (as requested in section (A)).

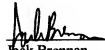
In consideration of the events described herein, Applicant respectfully requests the removal of the 49 days of APPL Delay resulting in a re-calculated determination of PTA at Allowance as follows:

- PTO Delay remains at 467 days
- APPL Delay adjusted from 49 to 0 days
- Total PTA adjusted from 418 days to 467 days

The petition fee required by 37 CFR 1.18(e) in the amount of \$200.00 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 13751-056001.

Thank you for your consideration of this Petition. If there are any questions or additional information required, please call the undersigned.

Respectfully submitted,

 December 19, 2006  
\_\_\_\_\_  
Jack Brennan  
Reg. No. 47,443

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Serial No.: 10/661,984  
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Title: NOVEL NEUROTROPHIC FACTORS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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DECLARATION OF MAILING BY "EXPRESS MAIL"

Francisco Robles declares as follows:

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New York, NY 10002

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2. On July 5, 2006, I deposited in the mail, "Express Mail Post Office to Addressee" service of the United States Postal Service, the contents of the envelope for which "Express Mail" receipt No. EV 915265692 US was issued addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
3. Attached hereto is a true copy of the "Express Mail" receipt No. EV 915265692 US.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patents issued thereon.

Date: July 5, 2006



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Agency's Dossier No. 13751-056001	Express Mail Label No. EV 915265692 US
Application No. 10/661,984	Mailing Date July 5, 2006
Title of the Invention NOVEL NEUROTROPHIC FACTORS	Filing Date September 12, 2003
Applicant Dinah W.Y. Sah et al.	Attorney/Secretary Init JQB/nds
Client Reference No. Biogen MacC045 US (IP2/N6GeneP)20US01	
Enclosures - Amendment/Response (4 pages) - 2 references: Kozbauer et al., <i>NATURE</i> 384:467-470 (1996); Lindahl et al., <i>J. Biological Chem.</i> 276:9344-9351 (2001).	

